



**BENELUX-BUREAU FOR INTELLECTUAL PROPERTY DECISION ON  
OPPOSITION  
N° 2017842  
from Feb. 27, 2023**

**Opposant:** **NIKE Innovate C.V., a limited partnership organized and existing under the laws of the Netherlands**

One Bowerman Drive  
97005-6453 Beaverton  
United States of America

**Authorized representative:** **NLO Shieldmark B.V.**

Anna van Buerenplein 21  
2595 DA The Hague The  
Netherlands

**Invoked trademark 1: Union trademark registration 277665**

AIR MAX

**Invoked trademark 2: Benelux registration 518971**

AIR MAX

*at*

**Defendant:** **MAVIC S.à.r.l.**

Rue de l'Industrie 11  
8399 Windhof  
Luxembourg

**Authorized representative:** **Merk-Echt B.V.**

Imperial Street 7  
4811 HL Breda  
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**Disputed sign:** **Benelux application 1455694**

MAX 1

## I. FACTS AND PROCEDURE

### A. Facts

1. On December 10, 2021, the defendant filed a Benelux application for the word mark MAX 1 for goods and services in classes 25, 35 and 41.

The application was processed under number 1455694 and published on Dec. 20, 2021.

2. On February 18, 2022, the opponent filed an opposition to the registration of this application. The opposition is based on the following earlier marks:

- European registration 277665 of the word mark AIR MAX, filed July 8, 1996 and registered November 23, 1998 for goods in classes 18, 25 and 28;
- Benelux registration 518971 of the word mark AIR MAX, filed June 12, 1992, and registered for goods in Class 25.

3. According to the Register, the opponent is actually the proprietor of the invoked earlier marks.

4. The opposition is filed against all goods in Class 25 of the challenged sign and is based on all goods of the earlier marks relied upon.

5. The procedural language is Dutch.

### B. Proceedings

6. The opposition was admissible and notified to the parties by the Benelux Office for Intellectual Property ("the Office") on February 22, 2022. In the course of the administrative phase of the proceedings, both parties submitted arguments. The proceedings proceeded in accordance with the requirements imposed on them by the Benelux Convention on Intellectual Property ("BTIP") and its Implementing Regulations ("UR"). The administrative phase was completed on October 19, 2022.

## II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES

7. The opponent argues on the following grounds that the disputed sign should not be registered:

- Article 2.2b(1)(b) BTIP: *"A trade mark shall not be registered if an opposition is filed against it [...] if: [...] b. it is identical with or similar to an earlier mark and relates to identical or similar goods or services and as a result there is a likelihood of confusion on the part of the public, including where such confusion results from association with the earlier mark."*
- Article 2.2b(3)(a) BTIP: *"Furthermore, a mark shall not be registered or, if registered, shall be liable to be declared invalid if an opposition is filed against it: a. if it is identical with or similar to an earlier mark regardless of whether the goods or services for which it is applied for or registered are identical with, similar to or dissimilar to those for which the earlier mark is registered, if the earlier mark has a reputation in the Benelux territory, or, in the case of a Union mark, a reputation in the European Union, and the use, without due cause, of the later mark takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier mark."*

**A. Arguments opponent**

8. Opposer argues with respect to the phonetic comparison of the signs that the pronunciation of the signs consists only of English words. The signs coincide in the sound of the identical element MAX. The disputed sign has an additional element, namely the digit 1. The digit 1 of the disputed sign, according to the opponent, can be seen as a number referring, for example, to the specific product line or version or as an allusion to quality, which is a common practice in branding, especially in clothing, where the digit 1 is usually used to indicate that it is the first or the best. Therefore, this element is not distinctive and can be considered a recommendation, an assessment or a sign of the quality of the MAX brand. This results in a comparison between the distinctive elements AIR MAX and MAX, with the element MAX being identical. Although the element AIR is not present in the disputed sign, phonetically there is a high degree of similarity. The pronunciation of the signs cannot be disputed, since they are English. The phonetic comparison between any of the elements is identical, resulting in an overall phonetically high degree of similarity. Thus, according to the opponent, the signs are phonetically very similar.

9. Regarding the visual comparison between the signs, the opponent notes that both signs involve word marks and are written in a standard font. As argued, the 1 has no distinguishing value in the disputed sign, requiring a comparison between AIR MAX and MAX. The similarity between the dominant identical elements AIR MAX and MAX is evident, since the dominant element of the disputed sign is included in its entirety in the earlier mark. Although the component AIR of the earlier marks is not present in the disputed sign, the public might think that this disputed sign is an addition or variation of the existing earlier mark. For example, a product in which AIR has no role. MAX 1 could be seen as part of the AIR MAX family owned by the opponent. According to the opponent, the signs are visually very similar.

10. According to the opponent, the signs are also conceptually very similar. In both the earlier marks and the disputed sign, MAX has the meaning of abbreviation of Maximum. Maximum has the meaning of "the greatest quantity or amount possible, assignable, allowable, etc. ". In light of the goods at issue, it is clear that all signs refer to that which is intended to be achieved, namely, the maximum. Therefore, the marks AIR MAX and MAX 1 all have the same dominant component with the same conceptual meaning. The component AIR is merely complementary to the component MAX, as part of an indication of the nature of the goods, according to the opponent.

11. The contested goods in Class 25 are all among the garments, footwear and headgear for which the invoked AIR MAX marks are registered. Thus, the contested goods in Class 25 are identical to the Class 25 goods of the earlier marks.

12. In the present case, both defendant and the opponent address the general shopping public. The attention level of the relevant audience, according to the opponent, is lower than average.

13. The identity of the goods and the high similarity of the signs should suffice to refuse the disputed sign, without the need to prove the highly distinctive character and/or the reputation of the opposing marks. Nevertheless, the earlier marks have high distinctiveness due to their long and intensive use in the relevant territory in connection with the opponent's goods in Class 25, so that, according to the opponent, they deserve broader protection than marks with average distinctiveness. The opponent substantiates the reputation of the relied upon marks with various figures and documents.

14. The opponent further points out that it has a family of trademarks (Union trademark AIR MAX, Benelux trademark AIR MAX, Benelux trademarks AIR MAX SQUARE and AIR MAX 2 and Union trademarks VAPORMAX and NIKE AIR VAPORMAX). The brands are all characterized by the presence of the same element, namely MAX. Thus, there are serial marks and this is a relevant element for assessing likelihood of confusion. Due to the addition of the 1 after the element MAX, the relevant consumer will believe that this sign is also part of the MAX family owned by the opponent. Especially since there is also an earlier mark AIR MAX 2. Therefore, there is a likelihood of confusion from the point of view of the trademark family, since the disputed sign could easily be included in the series of trademarks owned and used by the opponent.

15. Regarding the second ground invoked, Article 2.2ter (3) (a) BTIP, the opponent notes that the trademarks invoked are well known to a significant portion of the public for apparel products in the relevant areas. The variety of MAX trademarks began with the launch of the first AIR MAX in 1986. Today, it is one of, if not the, most popular shoes in the world. According to the opponent, this is evident from the documents submitted. Also, as explained, there is similarity between the signs, as this ground requires. In addition, there is unfair advantage. According to the opponent, the defendant seeks to establish an association with a well-known mark and thus obtain a clearly unfair advantage, which includes obtaining substantial benefits without having to make any effort to make its mark known. The disputed sign will exploit the reputation, image and prestige acquired by the earlier marks, leading to a situation of commercial parasitism. Defendant's use of MAX 1 is a means of generating additional consumer interest in its own goods, which are identical to the goods for which the earlier marks enjoy their reputation. This will lead to an unacceptable situation where the Respondent is allowed to "piggyback" on the Opponent's investments in promoting and building goodwill for its brand, as it promotes the success of the Respondent's goods to an extent that is disproportionately large compared to the size of its promotional investments. In view of the significant exposure of the affected consumers to the earlier marks, and in view of the similarity between the signs and the high distinctiveness of the earlier marks, the opponent believes that there is a strong likelihood that the use of the disputed sign without a valid reason for all of the disputed goods could lead to free-riding, i.e., that the disputed sign could take unfair advantage of the distinctiveness or reputation of the earlier marks. In addition, the use of the disputed sign may be detrimental to the earlier marks, in that its ability to immediately evoke an association with the opponent's business would be diminished.

16. In view of all the foregoing, the opponent requests that the Office grant the opposition for all Class 25 goods and order the defendant to pay the costs.

## **B. Respondent's response**

17. The defendant first notes that Max Verstappen is a 100% shareholder of the defendant. Defendant exploits the intellectual property rights of Formula One driver Max Verstappen.

18. Regarding the visual comparison of the signs, the defendant argues that the fact that letters between two signs match does not automatically mean that the signs are similar. Indeed, other additional elements can effectively distinguish the signs. The signs differ in their first word elements AIR versus MAX. In addition, the disputed character has an additional digit 1. More weight is given to the beginning of signs than to the end. Visually, therefore, the characters are different.

19. Phonetically, the disputed sign is pronounced in two words, MAX ONE, with emphasis on the second word ONE. The word MAX refers to the Dutch boy's name Max and is pronounced MAX. Contrary to the opponent's contention, the disputed sign does not consist of an English word. The relied upon marks are, however, pronounced in English as AIR MEX, with emphasis on the first syllable AIR. According to Defendant, the words AIR MEX and MAX ONE have no similarity aurally; each of the words has a different pronunciation. Moreover, the emphasis of the rights invoked and the disputed sign is on the differently pronounced words AIR and ONE respectively. Thus, phonetically, the signs are different.

20. Also on a conceptual level, the signs as a whole do not correspond. The word element MAX of the disputed sign is a boy's name, in this case the first name of Max Verstappen. The number 1 is Max Verstappen's race number. The word AIR in the rights invoked is the English word for "air. According to the opponent, the word MAX in the rights invoked refers to the adjective Maximum which means "the greatest quantity or amount possibly assignable, allowable, etc." means.

21. According to Defendant, the goods are non-serially similar. Regarding the reliance on the series mark argument, Defendant notes that of the six marks cited by Opponent, two are in fact one and the same mark, AIR MAX. The marks AIR MAX SQUARE and AIR MAX 2 Defendant has been unable to find in the registry. Defendant further points out that there are 654 trademarks registered in the Benelux containing the letter combination MAX and registered in class 25, of which the opponent is not the proprietor. The fact that hundreds of MAX trademarks from different owners exist and are actually used is a clear indication that the public will not perceive the opponent's trademarks as being part of a specific family of trademarks separate from those numerous other MAX trademarks. The Opposer has not, according to the Respondent, demonstrated that it has a serial trademark.

22. Regarding the reliance on Article 2.2ter paragraph 3 (a) BTIP, the defendant notes that the challenged sign is not similar to the invoked AIR MAX trademarks. Moreover, the proof of reputation submitted by the opponent concerns the combination NIKE AIR MAX and not the invoked AIR MAX trademarks. Since the trademarks invoked are neither well-known nor similar to the disputed sign, taking unfair advantage of and detriment to the trademarks invoked is not at issue. Moreover, the defendant has a valid reason for using the disputed sign: MAX is Max Verstappen's first name and the number 1 is his race number.

23. Defendant concludes that since the signs are clearly different from each other, the public will not establish a relationship with the opponent's marks when seeing the disputed sign. The public will also not assume that the marks come from one and the same company. Thus, there is no likelihood of confusion. Also, the disputed sign does not take unfair advantage and does not adversely affect the distinctive character and reputation of the trademarks invoked.

24. Respondent asks the Office to reject the opposition in its entirety, register the Benelux trademark application MAX 1 and order the opponent to pay the costs of the proceedings.

### **III. DECISION**

#### **A. Confusion hazard**

25. In accordance with Article 2.14 BTIP, the proprietor of an earlier mark may, within a period of two months from the publication of the application, file a written opposition with the Office against a mark which comes after his in order of priority, in accordance with the provisions of Article 2.2ter BTIP.

26. Article 2.2b (1) BTIP provides, in so far as relevant here: "*A trademark shall not be registered if an opposition is filed against it [...] if: [...] b. it is identical with or similar to an earlier trade mark and relates to identical or similar goods or services and as a result there is a likelihood of confusion on the part of the public, including where such confusion results from association with the earlier trade mark.*"<sup>1</sup>

27. There is a likelihood of confusion within the meaning of this provision where the public is liable to believe that the goods or services designated by that mark and those covered by the mark applied for come from the same undertaking or, as the case may be, economically connected undertakings.<sup>2</sup>

28. According to the settled case law of the Court of Justice of the European Union ("CJEU"), the existence of a likelihood of confusion must be assessed globally, taking into account all the relevant circumstances of the concrete case, including the degree of similarity of the conflicting signs and of the goods or services concerned, the degree of reputation of the earlier mark and the degree of - intrinsic or acquired through use - distinctiveness of the earlier mark.<sup>3</sup>

### **Comparison of characters**

29. To assess the degree of similarity between the conflicting signs, their degree of visual, auditory and conceptual similarity should be determined. The comparison should be based on the overall impression evoked by these signs. In the assessment, the average consumer's perception of the signs plays a decisive role. The average consumer usually perceives a sign as a whole and does not pay attention to its various details.<sup>4</sup>

30. Although the comparison must be based on the overall impression left by the signs in the memory of the relevant audience, it must nevertheless be made in light of the intrinsic qualities of the conflicting signs. The overall impression evoked by a composite sign to the relevant public may, in certain circumstances, be dominated by one or more of its components. In assessing whether this is the case, the intrinsic qualities of each of those components must be taken into account in particular by comparing them with the qualities of the other components. In addition, it may possibly be considered, how the different constituents in the configuration of the composite sign relate to each other.

31. In short, the assessment of the similarity of the signs should be based, as far as the visual, aural or conceptual similarity of the signs is concerned, on the overall impression evoked by the signs, taking into account, inter alia, their distinctive and dominant components.

32. The characters to be compared are the following:

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<sup>1</sup> Art. 2.2ter (1) (b) BTIP implements Art. 5 (1) (b) Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks. A similar provision can be found in Art. 8 (1) (b) Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the Union trade mark.

<sup>2</sup> CJEU June 11, 2020, C-115/19 P, ECLI:EU:C:2020:469, para. 54 (China Construction Bank).

<sup>3</sup> CJEU March 4, 2020, C-328/18 P, ECLI:EU:C:2020:156, para. 57 and the case law cited there (Equivalenza).

<sup>4</sup> CJEU March 4, 2020, C-328/18 P, ECLI:EU:C:2020:156, para. 58 and the case law cited there (Equivalenza).

| <b>Opposition based on:</b> | <b>Opposition directed against:</b> |
|-----------------------------|-------------------------------------|
| AIR MAX                     | MAX 1                               |

#### *Visual comparison*

33. The invoked marks are both pure word marks consisting of two words of both three letters: AIR MAX.

34. The disputed sign is also a pure word mark. It consists of one three-letter word, MAX, followed by the number 1.

35. In the relied upon marks, the elements AIR and MAX weigh equally in the overall impression. In the disputed mark, the emphasis is on the word MAX. The number 1 will be seen as a specification of MAX.

36. Both characters contain the word MAX. To that extent, the characters correspond. However, the word MAX is in a different place in the characters (at the beginning and at the end, respectively). Otherwise, the characters are also different.

37. In view of the foregoing, the Office finds that the signs are visually similar to some extent.

#### *Auditory comparison*

38. The invoked word marks consist of two words of a total of two syllables, AIR MAX. Most of the Benelux consumer, given the English word AIR known to the Benelux public, will pronounce these words in English as AIR MEX. Another part of the public will pronounce the marks as AIR MAX.

39. The disputed character consists of one word and one number and will be pronounced in two syllables: MAX ONE. The Benelux consumer will pronounce this sign in his own Dutch or French language, as MAX ÉÉN or MAX UN, with emphasis on the first part MAX.

40. In view of the foregoing, the Office finds that the signs are aurally similar to some extent.

#### *Conceptual comparison*

41. In the trademarks relied upon, the word AIR will be understood by the Benelux public as 'air'. The word 'MAX' will possibly be seen as an abbreviation of 'maximum' or 'maximum', but could also be understood as being a first name. In view of the foregoing, the Office is of the opinion that the relevant public as a whole will not assign a clear meaning to the sign AIR MAX.

42. In the disputed sign, the word MAX will possibly be understood by the Benelux public as a first name. In principle, however, a name has no specific meaning. This is only different when the name in question has become a conceptual symbol, for example due to the fame of the character bearing that name, or when the name in question has a clear and immediately recognizable

semantic content.<sup>5</sup> In the case of the common given name MAX, in the opinion of the Office, this is not the case. In addition, the word MAX in the disputed sign could also be seen as an abbreviation of 'maximum' or 'maximium'. According to the Bureau, the relevant public will therefore also not assign a clear meaning to the sign MAX 1.

43. In view of the above, a conceptual comparison is not at issue.

#### *Conclusion*

44. The signs match visually and aurally to some extent. A conceptual comparison is not an issue.

#### ***Comparison of goods and services***

45. When assessing the conformity of the goods and services in question, all the relevant factors characterizing the relationship between them must be taken into account. These include their nature, purpose and use, as well as their competitive or complementary nature.<sup>6</sup>

46. In comparing the goods and services, the goods and services are considered in the terms as listed in the register. Actual or intended use is not taken into account.<sup>7</sup>

47. The goods to be compared are as follows:

| <b>Opposition based on:</b>   | <b>Opposition directed against:</b> |
|---|-------------------------------------|
| Union<br>mark KI 18<br>Leather and imitation leather and goods made from these materials insofar as not included in other classes; Animal skins; Handbags and purses, trunks and travelling bags; Umbrellas, parasols and walking sticks; Whips and saddlery goods; Attachment cases; Backpacks; Shoulder straps of leather; Beach bags; Briefcases; Card holders [wallets]; Purses of mesh (not of precious metals); Collars for animals; Frames for umbrellas or umbrellas; Frames for umbrellas or umbrellas; Whey bags; Goldsmith's fleece; Sausage casings; Frames for handbags; Handbags; Knapsacks; Music folders; Shopping nets; Wallets; Purses; School bags; Shopping bags; Carrier bags for carrying children; Belts for Skates; Shoulder pads of buffalo leather; |                                     |

<sup>5</sup> General Court EU June 27, 2019, T-268/18, ECLI:EU:T:2019:452, paragraphs 85-90 (Luciano Sandrone) and June 18, 2021, T-386/20, ECLI:EU:T:2021:372, paragraph 54 (Miley Cyrus).

<sup>6</sup> CJEU Sept. 29, 1998, C-39/97, ECLI:EU:C:1998:442, para. 23 (Canon).

<sup>7</sup> General Court EU June 16, 2010, T-487/08, ECLI:EU:T:2010:237, para. 71 (Kremezin).



|  |   |
|--|---|
| <p>Handles for suitcases; Foedrals for umbrellas; Handles for umbrellas; Baleens for umbrellas or umbrellas; Umbrella loops; Umbrella sticks; Beauty cases [empty]; Handles for walking sticks; Handles for walking sticks; Seat sticks; Shopping bags with wheels.</p>  |   |
| <p>Union brand</p> <p>KI 25 Garments, footwear, headgear; Boot shafts; Flaps of caps; Sousbras; Iron fittings for footwear; Upper leather of footwear; Frames for hats; Heels for footwear; Heels for stockings; Heels; Insoles; Anti-slip devices for boots and shoes; Pockets of garments; Linings, made up [parts of garments]; Plastrons for shirts; Inserts for shirts; Soles; Studs for soccer shoes; Noses for footwear; Shoe rims.</p> <p>Benelux brand</p> <p>KI 25 Clothing, footwear, headgear.</p> | <p>CI 25 Clothing, footwear, headgear; T shirts; polo shirts, sweatshirts; hooded sweatshirts; jackets; sports jackets; caps; caps; scarves; headbands; wristbands; suits; belts [belts]; underwear; socks; overalls; gloves [clothing]; parts of the aforementioned goods.</p> |
| <p>Union brand</p> <p>KI 28 Toys and games; Gymnastic and sports equipment, not included in other classes (except tennis, badminton and squash rackets and golf equipment ); Decorations for Christmas trees.</p>  |   |

#### Class 25

48. The goods "*Garments, footwear, headgear; parts of the aforementioned goods*" for which the challenged sign is registered in Class 25 are identical to the "*Garments, footwear, headgear*" for which the relied upon marks are registered in Class 25.

49. The goods "*T-shirts; polo shirts, sweaters; hooded sweatshirts; jackets; sport jackets; suits; underwear; socks; overalls; parts of the aforesaid goods.*" of the challenged sign fall within the broader category of "*Garments*" for which the relied upon marks are registered in Class 25 and are therefore deemed to be identical.<sup>8</sup>

50. The goods "*caps; caps; parts of the aforementioned goods*" of the disputed sign fall within the broader category of "*Headgear*" for which the relied upon marks are registered in Class 25 and are therefore deemed to be identical.<sup>9</sup>

<sup>8</sup> General Court EU Feb. 2, 2022, T-694/20, ECLI:EU:T:2022:45, para. 31 and the case law cited there (Labello).

<sup>9</sup> General Court EU Feb. 2, 2022, T-694/20, ECLI:EU:T:2022:45, para. 31 and the case law cited there (Labello).

51. The goods "*scarves; headbands; wristbands; belts [belts]; gloves [clothing]; parts of the aforesaid goods*" are, in the opinion of the Office, similar to the "*Garments, footwear, headgear*" for which the relied upon marks are registered in Class 25. All these goods have the same purpose, which is to cover or protect the body. In addition, the points of sale and distribution channels of these goods are mostly the same.

#### *Conclusion*

52. The goods of the disputed sign are partly identical and partly similar to the goods of the invoked marks.

#### **Global assessment**

53. The global assessment must be based on the average consumer of the goods or services in question, who is reasonably well informed and reasonably observant and circumspect. It should be borne in mind, however, that the average consumer rarely has the opportunity to make a direct comparison between different brands, but is guided by the imperfect perception that has remained with him. It should also be taken into account that the average consumer's level of attention may vary according to the type of goods or services at issue.<sup>10</sup> In this case, the Office assumes a normal level of attention of the relevant public. The goods at issue are aimed at a large and varied audience whose attention level cannot be said to differ from that of the average consumer.

54. The likelihood of confusion is all the greater the stronger the distinctiveness of the earlier mark. Marks which, either inherently or because of their reputation in the market, have a strong distinctive character therefore enjoy broader protection than marks with a low distinctive character.<sup>11</sup> In this case, the opponent has argued in its arguments in support of the opposition that the trademarks relied upon have acquired a heightened distinctive character and enjoy a reputation. However, the documents submitted in support thereof refer to the sign NIKE AIR MAX and not to the sign AIR MAX, as the Respondent correctly argues. The Office will therefore assume normal distinctiveness of the relied upon marks.

55. The global assessment of the likelihood of confusion presupposes a certain interrelationship between the factors to be taken into account, in particular between the similarity of the conflicting signs and the goods or services to which they relate. Thus, a low degree of similarity of the goods or services concerned may be offset by a high degree of similarity between the signs, and vice versa.<sup>12</sup>

56. The goods involved are partly identical and partly similar. Visually and aurally, there is a degree of similarity between the signs. On the basis of these and the other factors mentioned above, and in view of their interrelationship, the Office considers that there is a likelihood of confusion in that the public may believe that the goods designated by the trademarks invoked and those of the disputed sign come from the same undertaking or, as the case may be, from economically related undertakings. Since it is common in the clothing sector for the same mark to be configured in different ways, the relevant public might also believe that the disputed sign is a sub-brand of the opponent.<sup>13</sup>

<sup>10</sup> CJEU June 22, 1999, C-342/97, ECLI:EU:C:1999:323, para. 26 (Lloyd Schuhfabrik Meyer).

<sup>11</sup> CJEU Sept. 29, 1998, C-39/97, ECLI:EU:C:1998:442, para. 18 (Canon).

<sup>12</sup> CJEU March 4, 2020, C-328/18 P, ECLI:EU:C:2020:156, para. 59 and the case law cited there (Equivalenza).

<sup>13</sup> General Court EU October 6, 2004, T 117/03 to T 119/03 and T 171/03, ECLI:EU:T:2004:293, para. 51 (NLSPORT).

**Other factors**

57. The opponent has pointed out that it has a MAX family of trademarks, or a series trademark, as a result of which there is a likelihood of confusion due to the defendant's use of the MAX element (see above under 14). To the extent that it can already be assumed that there is a serial trademark, an appeal to this can only succeed if use as a series is demonstrated. This is because the existence of a danger that the public will believe that the disputed sign belongs to a "family" or "series" requires that the earlier marks that are part of that "family" or "series" are present in the market.<sup>14</sup> Now that use as a series has not been proven, the series mark argument cannot succeed.

58. The Respondent further submits that there are 654 trademarks registered in Benelux containing the letter combination MAX and registered in Class 25, of which the Opponent is not the proprietor (see supra note 21). In so far as the Respondent intends to argue that this reduces the likelihood of confusion, the Office notes that while it is not excluded that in certain cases coexistence of earlier marks in the market may reduce the likelihood of confusion, this can only be taken into account if it is shown in the opposition proceedings that such coexistence is based on the fact that there is no likelihood of confusion on the part of the relevant public between those other MAX marks and the marks invoked in this opposition, and subject to the proviso that the marks in question are identical.<sup>15</sup>

59. The Respondent further argues that MAX 1 refers to Max Verstappen and his race number 1. As a result, according to the Respondent, the public will not establish a relationship with the Opponent's trademarks when seeing the disputed sign (see above under 20 and 23). In this regard, the Office notes that in opposition proceedings it must start from the disputed sign as filed. It cannot take into account how the disputed sign is used in practice. Furthermore, the test to be applied by the Office is not whether there is actual confusion on the part of the public, but whether there is a danger (read: a possibility) of confusion. Based on the case law of the CJEU, this likelihood of confusion should be determined normatively on the basis of the criteria used above.

**B. Conclusion**

60. Based on the foregoing, the Office concludes that a likelihood of confusion exists.

61. Since the opposition is already upheld on the basis of Article 2.2b(1)(b) of the BTIP, an assessment on the other ground invoked, namely Article 2.2b(3)(a) of the BTIP, can be dispensed with.

**IV. DECISION**

62. Opposition number 2017842 is granted.

63. The Benelux application with number 1455694 is not registered for:

- class 25 (all goods).

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<sup>14</sup> General Court EU 13 September 2007, C-234/06 P, ECLI:EU:C:2007:514, para. 64 (Brainbridge).

<sup>15</sup> General Court EU Jan. 20, 2010, T-460/07, ECLI:EU:T:2010:18, para. 68 and the case law cited there (LIFE BLOG).

64. However, the Benelux application with number 1455694 is registered for the following services because the opposition was not directed against it:

- Class 35 (all services);
- Class 41 (all services).

65. The defendant owes 1,045 euros to the opponent pursuant to Article 2.16(5) BTIP in conjunction with Rule 1.28(3) UR, as the opposition is upheld in its entirety. This decision constitutes enforceable title under Article 2.16(5) BTIP.

The Hague, Feb. 27, 2023



Marjolein Bronneman  
(*rapporteur*)

Pieter Veeze

Camille Janssen

Administrative handler: Guy  
Abrams